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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number

9423.0028-01Customer No. **22,852**Finnegan, Henderson,
Farabow, Garrett & Dunner,
LLP

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Application Number

10/736,331

Filed

December 15, 2003

First Named Inventor

Anthony R. TREMAGLIO

Art Unit

3767

Examiner

Sharon KENNEDY

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

Signature

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

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April 6, 2006

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

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PATENT
Customer No. 22,852
Attorney Docket No. 9423.0028-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Anthony R. TREMAGLIO, Jr. et al.) Group Art Unit: 3767
Application No.: 10/736,331) Examiner: Sharon KENNEDY
Filed: December 15, 2003) Confirmation No.: 3713
For: APPARATUS AND METHODS)
FOR GUIDING A NEEDLE)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of certain claims rejections applied against this application in the final Office Action mailed December 13, 2005. This Request is being filed with a Notice of Appeal.

I. Compliance With Requirements For Submitting a Pre-Appeal Brief Request for Review

This submission complies with the requirements for requesting a pre-appeal brief review because: (1) the present application has been at least twice rejected; (2) this Request is being filed with a Notice of Appeal prior to the filing of an Appeal Brief; and (3) this Request is five or less pages in length and sets forth legal and/or factual deficiencies in the final rejections. See Official Gazette Notice, July 12, 2005.

II. Status of the Claims

Claims 80-99 are pending in this application, with claims 84, 85, and 93 having been withdrawn from further consideration by the Examiner. Claim 80 is the sole independent claim. In the final Office Action, claims 80-83, 86-92, and 94-99 were finally rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,193,692 to Harris et al. ("Harris"), and claims 80, 82, 83, 86-92, and 94-99 were finally rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,623,521 to Shaw ("Shaw").

III. Scope of Review

In the final Office Action, the Examiner did not reject dependent claim 81 based on Shaw. Therefore, the final rejection of claim 81 is based solely on Harris. This request for a pre-appeal brief review addresses the rejection of claim 81 and requests withdrawal of that rejection. As set forth in Applicants' Amendment After Final of February 10, 2006, Applicants proposed to amend claim 81 to place it in independent form to place this case in condition for allowance. The Examiner refused entry of that amendment, asserting that it raised new issues despite simply placing claim 81 in independent form (and canceling the rejected independent claim 80). Should this request for review result in the withdrawal of the claim 81 rejection, Applicants intend to amend the application as set forth in the previously filed Amendment After Final.

IV. Grounds for Traversing Final Rejection

The final Office Action does not establish a *prima facie* case of anticipation in rejecting at least claim 81 over Harris at least because Harris does not disclose every aspect recited in claim 81 of this application, as described below. In particular, Harris

does not disclose first and second assemblies that "seal together and are separable...such that body fluid cannot pass through the needle when the first and second assemblies are sealed together," as set forth in claim 81. Harris does not disclose any embodiment where fluid cannot pass through its outer sheath member 12 and its stylet subassembly 30.

In the rejections based on Harris, the Examiner refers to "the comments set forth in the previous office action." (Final Office Action at Page 2.) In that prior action, the Examiner pointed to item 32 in FIG. 6 of Harris as corresponding to the claimed stylet and item 22 in FIG. 6 as corresponding to the claimed second assembly. (See June 28, 2005 Office Action at Pages 2-3.)

As previously argued in the reply of September 23, 2005, the Harris device cannot meet the recitations of claim 81 since Harris requires that gas or fluid flows through outer sheath member 12 and stylet subassembly 32 for the purpose of insufflating a body cavity. (See, e.g., Harris at column 3, lines 43-52 and Figures 2-7.) The Harris devices provide for fluid flow therethrough when stylet subassembly 32 and sheath 12 are connected. Harris discusses the connection of the device to a gas source and the flow rate through subassembly 32 at, for example, column 4, lines 17-31.

On pages 2-3 of the final Office Action, the Examiner found these arguments unpersuasive, arguing that FIG. 10 and column 5, lines 56+ of Harris disclose a "fluid tight arrangement." In FIG. 10 of Harris, the inner projection 32 is replaced with an inner projection 82 and a plug section 84, which extends beyond the outer sheath member 12.

The passages referred to by the Examiner, however, expressly disclose that “[t]he **flow path for this configuration** is through the gap between the inner bore 20 and the solid projection 82.” (Harris at column 5, lines 62-64.) (Emphasis added.) While the presence of item 82 in tubular sheath 12 may partially restrict the flow path therethrough (see Harris at column 5, lines 64-67), just as inner projection 32 may (see Harris at column 4, lines 29-31), nothing in the embodiment of FIG. 10 prevents body fluid from passing therethrough. To the contrary, lines 62-64 of column 5 in Harris expressly disclose that fluid **does** flow through sheath 12.

For at least these reasons, there are clear errors in the Examiner’s rejection of claim 81, and Applicant respectfully requests that the rejection of claim 81 (and claims 92, 93, 97, and 98, dependent thereon) be withdrawn.

V. Conclusion

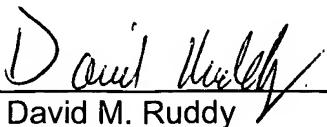
In light of the above arguments, the Examiner has failed to establish a *prima facie* case of anticipation of at least pending claims 81, 92, 93, 97, and 98.

Because the rejections include factual and/or legal deficiencies with regard to 35 U.S.C. § 102(b), Applicants are entitled to a pre-appeal brief review of the final Office Action and Advisory Action, and request that the rejection of claims 81, 92, 93, 97, and 98 be withdrawn and the claims allowed.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 6, 2006

By: 

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